The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JEFF A. BARNHORST and
DEAN A. OESTER

Appeal No. 2002-0435
Application No. 08/946,087

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and SCHEINER, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 and 3 through 11, which are all of the claims pending in the application.[1]

Claims 1 and 5, which are illustrative of the subject matter on appeal, read as follows:

1. A process for removing polyol impurities from a sorbitan ester solution comprising:

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[1] As stated in the Examiner's Answer, Paper No. 21, section (3), claims 12-21 have been canceled.

(a) providing a sorbitan ester solution containing polyol impurities;

(b) adding to the sorbitan ester solution from about 0.01 to about 10% actives, based on the total weight of final crude ester product formed, of a silica component;

(c) mixing the sorbitan ester solution and silica component;

(d) adsorbing the polyol impurities from the sorbitan ester solution onto the silica to form a mixture of polyol-containing silica and sorbitan ester; and

(e) removing the polyol-containing silica from the sorbitan ester solution.

5. The process of claim 1 wherein the silica is added to the sorbitan ester solution at a temperature of from about 30°C to about 80°C, with agitation.

The prior art reference relied on by the examiner is:

Stockburger	4,297,290	Oct. 27, 1981

Claims 1 and 3 through 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Stockburger.

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Appeal Brief (Paper No. 20); (3) the Examiner's Answer (Paper No. 21); and (4) the above-cited Stockburger Patent.

On consideration of the record, including the above-listed materials, we affirm the examiner's rejection of claims 1, 3, 4, and 6 through 11 under 35 U.S.C. § 103(a). However, we reverse the rejection of claim 5 under 35 U.S.C. § 103(a).

Discussion

Initially, we point out that claim 3 depends from canceled claim 2. On return of this application to the examining corps, we recommend that applicants correct this

inadvertent error.

We also note that applicants' Appeal Brief is internally inconsistent. In the section entitled "GROUPING OF THE CLAIMS," applicants state that all of the appealed claims stand or fall together. Nevertheless, applicants argue dependent claim 5 separately (Paper No. 20, paragraph bridging pages 5 and 6; and page 6, first complete paragraph). On the particular facts of this case, we find that the specific argument with respect to claim 5 "trumps" the pro forma grouping of the claims, and we shall treat claim 5 separately from independent claim 1. However, we shall treat dependent claims 3, 4, and 6 through 11 as standing or falling together with claim 1 because applicants expressly state that all claims stand or fall together and do not argue any of those dependent claims separately.

Claim 1

Applicants argue that Stockburger fails to disclose or suggest the amount of silica recited in claim 1, step (b). Applicants' argument, however, is predicated on the incorrect premise that the lower end of the range recited in step (b) is 1% silica. In fact, claim 1, step (b) provides

> adding to the sorbitan ester solution from about 0.01 to about 10% actives, based on the total weight of final crude ester product formed, of a silica component [emphasis added].

Applicants' position to the contrary, notwithstanding, the lower limit of added silica in claim 1 is from about 0.01% and not 1%.

As correctly found by the examiner, the amount of added silica disclosed by Stockburger in Example 1, part B, is .41% which meets claim 1 on appeal. That is, the

range "from about 0.01 to about 10%" added silica in claim 1, step (b) "reads on" Stockburger's .41% added silica.

There is no other readily identifiable difference between the process sought to be patented in claim 1 and the process disclosed by Stockburger in Example 1, part B; and no other difference is argued by applicants. On this record, therefore, we find that claim 1 is anticipated by Stockburger within the meaning of 35 U.S.C. § 102(b). As often stated by the Federal Circuit and its predecessor courts, lack of novelty in the claimed subject matter is the "ultimate or epitome of obviousness." See Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974); In re May, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978). On this basis, we affirm the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Stockburger.

As previously indicated, dependent claims 3, 4, and 6 through 11 fall together with independent claim 1.

Claim 5

Applicants' claim 5 depends from claim 1 and requires that the silica be added to the sorbitan ester solution at a temperature of from about 30°C to about 80°C, with agitation. The Stockburger reference, in part B of Example 1, discloses that its diatomaceous earth is added at a temperature of 101°C, which is well outside applicants' claimed temperature range. Nor does Stockburger provide any guidance which would have led a person having ordinary skill in the art to modify the teachings in Example 1, part B, in a manner which would result in using applicants' claimed temperature range. Accordingly, it is our judgment that Stockburger constitutes

insufficient evidence to support a conclusion of obviousness of claim 5 on appeal.

According to the examiner, the "claims" differ from Stockburger's process by reciting a different temperature (Paper No. 21, page 5, first paragraph). This apparently refers to the process of dependent claim 5, because that claim, and that claim alone, recites a temperature range. The examiner argues that "optimization of a known reaction process is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 105 U.S.P.Q. 233 (C.C.P.A. 1955)." As stated in In re Sebek, 465 F.2d 904, 907, 175 USPQ 93, 95 (CCPA 1972), however, "while it may ordinarily be the case that the determination of optimum values for the parameters of a prior art process would be at least prima facie obvious, that conclusion depends upon what the prior art discloses with respect to those parameters." Here, Stockburger discloses that its diatomaceous earth is added at a temperature of 101°C; and there is no other disclosure in Stockburger which would have led a person having ordinary skill to a lower temperature range. On these facts, we conclude that the process sought to be patented in claim 5, where silica is added at a temperature from about 30°C to about 80°C, would not have been obvious based on Stockburger alone.

The rejection of claim 5 under 35 U.S.C. § 103(a) as unpatentable over Stockburger is reversed.

Conclusion

In conclusion, for the reasons set forth in the body of this opinion, we affirm the examiner's decision rejecting claims 1, 3, 4, and 6 through 11. However, we reverse

the examiner's decision rejecting claim 5. Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Sherman D. Winters Administrative Patent Judge	)
William F. Smith Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
Toni R. Scheiner Administrative Patent Judge	)

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